

REMARKS

After entry of this amendment, claims 1-131 and 192-273 will be pending. Applicants believe that no new matter has been introduced by the above amendments. As the application has already published as United States Patent Application Publication No. US 2004/0106625 A1 on June 3, 2004, Applicants believe the submission of a substitute specification containing the current amendments is not required.

The specification has been amended to correct typographical and/or clerical errors. Specifically, on page 52, line 5, the misprint of “(R)-configuration” has been corrected to “(S)-configuration”. Support for this amendment may be found, *inter alia*, in Compounds BQO(b) through BSD(b) on pages 123-125 of Table 4 and Compounds CCK(b) through CDZ(b) on pages 135-137 of Table 5. On page 169, line 5, the misprint of “-(C₃-C₇)heterocycle” has been corrected to “-(C₃-C₅)heterocycle”.

Claims 1, 19, 21-23, 41, 42, 60, 62-64, 82-84, 100 and 101 have been amended to correct typographical and/or clerical errors. New claims 237-273 have been added. Claims 132-191 have been canceled without prejudice solely to expedite the allowance of the remaining claims. Applicants expressly reserve the right to file one or more continuation and/or divisional applications directed to the subject matter of the canceled claims and/or subject matter of the present amendments.

Support for the new claims may be found, *inter alia*, at the location(s) in the initially filed specification and claims as indicated below:

CLAIM NO.	EXEMPLARY SUPPORT
New claim 237	Page 65, line 25 of the specification; original claim 83
New claims 238 and 239	Page 45, lines 15 and 18; Compounds AAA through AFJ in Table 1 on pp. 81-86 of the specification
New claims 240-242 and 248-250	Compounds AAA-AAC, AAM-AAG, ABA-ABE, ABO and ABP in Table 1 on pp. 81-82 of the specification; original claims 6-8
New claims 243, 244, 251 and 252	Compounds AAG, AAU and ABI in Table 1 on pp. 81-82 of the specification
New claims 245, 246, 253 and 254	Compounds AAI, AAW and ABK in Table 1 on pp. 81-82 of the specification
New claims 247 and 265	Page 45, lines 22 and 26 of the specification
New claims 255-257	Page 45, lines 15 and 19; page 46, line 14; Compounds BJO through BOX in Table 4 on pp. 117-122; Compounds BVK through CAT in Table 5 on pp. 129-134 of the specification

CLAIM NO.	EXEMPLARY SUPPORT
New claims 258-260 and 266-268	Compounds BJO-BJQ, BKA-BKE, BKO-BKS, BLC and BLD in Table 4 on pp. 117-118; Compounds BVK-BVM, BVW-BWA, BWK-BWO, BWY and BWZ in Table 5 on pp. 129-130 of the specification; original claims 6-8
New claims 261, 262, 269 and 270	Compounds BJU, BKI and BKW in Table 4 on pp. 117-118; Compounds BVQ, BWE and BWS in Table 5 on pp. 129-130 of the specification
New claims 263, 264, 271 and 272	Compounds BJW, BKK and BKY in Table 4 on pp. 117-118; Compounds BVS, BWG and BWU in Table 5 on pp. 129-130 of the specification
New claim 273	Compound BJU in Table 4 on page 117; Compound BVQ in Table 5 on page 129 of the specification

The Restriction Requirement

In the Office communication of December 27, 2005, a Restriction Requirement was imposed under 35 U.S.C. § 121 as follows, requiring election of one of the following groups for prosecution on the merits, each of which is alleged to encompass a separate invention:

- I. Compounds and compositions according to claim 1, of Formula I, classified in class 546, various subclasses;
- II. Compounds and compositions according to claim 23, of Formula II, classified in class 544, various subclasses;
- III. Compounds and compositions according to claim 42, of Formula III, classified in class 544, subclass 242;
- IV. Compounds and compositions according to claim 64, of Formula IV, classified in class 544, subclass 233;
- V. Compounds and compositions according to claim 83, of Formula V, classified in class 548, subclass 100+;
- VI. Compounds and compositions according to claim 84, of Formula VI, classified in classes 544 or 548, various subclasses;
- VII. Compounds and compositions according to claim 101, of Formula VII, classified in class 544 or 548, various subclasses;
- VIII. Methods of treating according to claims 117-206 of Formula I, classified in class 514;

- IX. Methods of treating according to claims 117-206 of Formula II, classified in class 514;
- X. Methods of treating according to claims 117-206 of Formula III, classified in class 514;
- XI. Methods of treating according to claims 117-206 of Formula IV, classified in class 514;
- XII. Methods of treating according to claims 117-206 of Formula V, classified in class 514;
- XIII. Methods of treating according to claims 117-206 of Formula VI, classified in class 514;
- XIV. Methods of treating according to claims 117-206 of Formula VII, classified in class 514;
- XV. Methods of preparing according to claims 222-236 of Formula I, classified in classes 544 and 548;
- XVI. Methods of preparing according to claims 222-236 of Formula II, classified in classes 544 and 548;
- XVII. Methods of preparing according to claims 222-236 of Formula III, classified in classes 544 and 548;
- XVIII. Methods of preparing according to claims 222-236 of Formula IV, classified in classes 544 and 548;
- XIX. Methods of preparing according to claims 222-236 of Formula V, classified in classes 544 and 548;
- XX. Methods of preparing according to claims 222-236 of Formula VI, classified in classes 544 and 548;
- XXI. Methods of preparing according to claims 222-236 of Formula VII, classified in classes 544 and 548;
- XXII. Kits according to claims 207-221 of Formula I, classified in class 206, subclass 569;
- XXIII. Kits according to claims 207-221 of Formula I, classified in class 206, subclass 569;
- XXIV. Kits according to claims 207-221 of Formula I, classified in class 206, subclass 569;
- XXV. Kits according to claims 207-221 of Formula I, classified in class 206, subclass 569;

- XXVI. Kits according to claims 207-221 of Formula I, classified in class 206, subclass 569;
- XXVII. Kits according to claims 207-221 of Formula I, classified in class 206, subclass 569; and
- XXVIII. Kits according to claims 207-221 of Formula I, classified in class 206, subclass 569.

Thereafter, a telephonic discussion was held between Applicants' representative George A. Senich, Reg. No. 42,140, and Examiner Ward on March 9, 2006 ("interview") to clarify certain issues of Applicants in connection with the Restriction Requirement for the above-identified application, thereby advancing the prosecution of the application, and not to discuss the patentability of the pending application. Applicants are grateful for the courtesies extended by Examiner Ward. During the interview, Mr. Senich discussed the status of claims 1-236. Pursuant to MPEP § 713.04, Applicants submit the statement of the substance of the Applicants-initiated interview within the remarks below.

Requests for Clarification

1. At the outset, Applicants note an inconsistency in the assignment of claim 84 to Group VI. Group VI is said to relate to Formula VI. However, claim 84 depends from claim 83; claim 83 (assigned to Group V) recites Formula V. As Applicants understand it from the interview, the Examiner intended to have Group VI relate to claim 100, which recites Formula VI. However, Applicants respectfully request written clarification in the next communication from the Office.

2. Applicants further note that certain claims, i.e., claims 2-22, 24-41, 43-63, 65-82, 85-100 and 102-116, have not been assigned to any of the above groups. As Applicants understand it from the interview, the Examiner intended to have claims 2-22, each relating to a Formula I, be assigned to Group I, claims 24-41, each relating to a Formula II, be assigned to Group II, etc. However, Applicants respectfully request written clarification in the next communication from the Office.

3. Applicants further note that Groups XXII through XXVIII are identical. As Applicants understand it from the interview, the Examiner intended to have Group XXIII relate to Formula II, Group XXIV relate to Formula III, etc. However,

Applicants respectfully request written clarification in the next communication from the Office.

4. Applicants further note an inconsistency in the assignment of claims to Groups XXII through XXVIII. For example, although claims 207-221 have been assigned to Group XXII, only claim 207 relates to Formula I while, e.g., claim 208 relates to Formula Ia, claim 209 relates to Formula Ib, claim 210 relates to Formula Ic, claim 211 relates to Formula II, claim 212 relates to Formula IIa, claim 213 relates to Formula III, etc. As Applicants understand it from the interview, the Examiner intended to have claims 207-210, each relating to a Formula I, be assigned to Group XXII, claims 211 and 212, each relating to a Formula II, be assigned to Group XXIII, etc. However, Applicants respectfully request written clarification in the next communication from the Office.

5. Applicants further note an inconsistency in the assignment of claims to Groups VIII through XIV. For example, although claims 117-206 have been assigned to Group VIII, only claims 117, 132, 147, 162, 177 and 192 relate to Formula I while, e.g., claims 118, 133, 148, 163, 178 and 193 relate to Formula Ia; claims 119, 134, 149, 164, 179 and 194 relate to Formula Ib; claims 120, 135, 150, 165, 180 and 195 relate to Formula Ic; claims 121, 136, 151, 166, 181 and 196 relate to Formula II; claims 122, 137, 152, 167, 182 and 197 relate to Formula IIa; claims 123, 138, 153, 168, 183 and 198 relate to Formula III; etc. As Applicants understand it from the interview, the Examiner intended to have claims 117-120, 132-135, 147-150, 162-165, 177-180 and 192-195, each relating to a Formula I, be assigned to Group VIII, claims 121, 122, 136, 137, 151, 152, 166, 167, 181, 182, 196 and 197, each relating to a Formula II, be assigned to Group IX, etc. However, Applicants respectfully request written clarification in the next communication from the Office.

6. Applicants further note an inconsistency in the assignment of claims to Groups XV through XXI. For example, although claims 222-236 have been assigned to Group XV, only claim 222 relates to Formula I while, e.g., claim 223 relates to Formula Ia, claim 224 relates to Formula Ib, claim 225 relates to Formula Ic, claim 226 relates to Formula II, claim 227 relates to Formula IIa, claim 228 relates to Formula III, etc. As Applicants understand it from the interview, the Examiner intended to have claims 222-226, each relating to a Formula I, be assigned to Group XV, claims 226 and 227, each relating to a Formula II, be assigned to Group XVI, etc. However, Applicants respectfully request written clarification in the next communication from the Office.

Traverse of the Restriction Requirement

Applicants respectfully traverse the Restriction Requirement.

Specifically, Applicants request that the requirement be modified to the extent that:

- the groups encompassing Formulae VI and VII, i.e., Groups VI and VII, be combined and examined together,
- Groups VIII through XIV be combined and examined together,
- Groups XV through XXI be combined and examined together, and
- to the extent that Groups XXIII through XXVIII are even retained, Groups XXII through XXVIII be combined and examined together

in the above-identified application. For the reasons provided below, Applicants submit that the subject matter of these claims merits combined examination.

In particular, Applicants submit that a search of the art for the compounds of Formula VII having a link comprising three carbon atoms between the amine nitrogen atom and Ar₂, as recited in independent claim 101, will also likely yield the prior art, if any, for the compounds of Formula VI having a link comprising two carbon atoms between the amine nitrogen atom and Ar₂, as recited in independent claim 100. That is, a search of the prior art for the subject matter of Group VII, viz the compounds of Formula VII, would encompass not only art disclosing such compounds but also art disclosing the compounds of Formula VI. Applicants further note that, for the compounds and compositions presently classified into Groups VI and VII, each group is classified into the same classes -- classes 544 and 548. Therefore, Applicants respectfully submit that, as any art identified in a search by the Examiner for the compounds of Group VII will likely also encompass the compounds of Formula VI, under M.P.E.P. § 803 the subject matter of Group VII and Formula VI can be examined together in a single application without imposing a serious burden on the Examiner. The M.P.E.P. § 803 (Eighth Edition, Revision 3, August 2005) provides that:

If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.

As Applicants understand it from the interview, the Examiner agreed to combine Groups VI and VII for this reason and examine the combination. Applicants respectfully request written clarification in the next communication from the Office.

Applicants note that for the methods of treating, presently classified into Groups VIII through XIV, each group is classified into the same class -- class 514. Thus, a search of the prior art for the subject matter of, e.g., Group VIII, *viz* the compounds of Formula I, would encompass not only art disclosing such methods but also art disclosing the methods of Groups IX through XIV. Therefore, Applicants respectfully submit that any art identified in a search by the Examiner for the methods of Group VIII will necessarily encompass the methods of Groups IX through XIV. Applicants further submit that, under M.P.E.P. § 803, the subject matter of claims 117-131 and 192-206 (claims 132-191 having been canceled without prejudice) can be examined together in a single application without imposing a serious burden on the Examiner.

Moreover, Applicants note that for the methods of preparing, presently classified into Groups XV through XXI, each group is classified into the same classes -- classes 544 and 548. Thus, a search of the prior art for the subject matter of, e.g., Group XV, *viz* the compounds of Formula I, would encompass not only art disclosing such methods but also art disclosing the methods of Groups XVI through XXI. Therefore, Applicants respectfully submit that any art identified in a search by the Examiner for the methods of Group XV will necessarily encompass the methods of Groups XVI through XXI. Thus, under M.P.E.P. § 803, the subject matter of claims 222-236 can be examined together in a single application without imposing a serious burden on the Examiner.

Applicants note that, as the Office communication states, on page 5, that “a search of the four groups designated above would impose ...” (emphasis added), perhaps it is already contemplated that Groups I through VII be combined into one “master group 1,” Groups VIII through XIV be combined into one “master group 2,” Groups XV through XXI be combined into one “master group 3,” and Groups XXII through XXVIII be combined into

one “master group 4”.

Applicants also note that, as they understand it from the interview, upon the allowability of subject matter for a compound and/or composition (i.e., a claim(s) from present Groups I through VII) the Examiner intends to rejoin to the above-identified application:

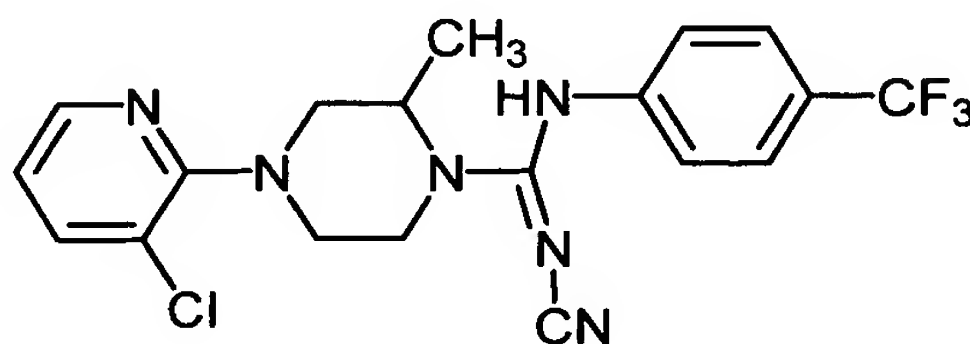
- method of treating claim(s) dependent therefrom (i.e., a claim(s) from present Groups VIII through XIV),
- method of preparing claim(s) dependent therefrom (i.e., a claim(s) from present Groups XV through XXI), and
- kit claim(s) dependent therefrom (i.e., a claim(s) from present Groups XXII through XXVIII).

Applicants respectfully request clarification in the next communication from the Office.

Accordingly, Applicants respectfully request that the Restriction Requirement under 35 U.S.C. § 121 be reconsidered and revised.

Provisional Election

However, in order to be fully responsive to the outstanding Restriction Requirement, Applicants hereby provisionally elect, with traverse, as the specifically disclosed species of the invention to be examined for search purposes (as requested on page 5 of the Office communication), Compound BVQ (see Table 5, page 129, line 21 of the specification), i.e.:



Compound BVQ

Applicants note that claim 21, reciting Formula Ib, claims 104, 119, 194, 209 and 224, and new claims 255-257, 261, 262, 265, 269, 270 and 273 read on Compound BVQ. *Inter alia*, claim 21 is believed to be generic. However, the Office communication does not assign claim 21 to any of the above Groups I through XXVIII. To the extent that claim 21 is in Group I, claim 1 of which recites Formula I, Applicants provisionally elect, with traverse, a Group I which includes claim 21.

These provisional elections are made without prejudice to Applicants' right to pursue the non-elected subject matter in one or more related applications.

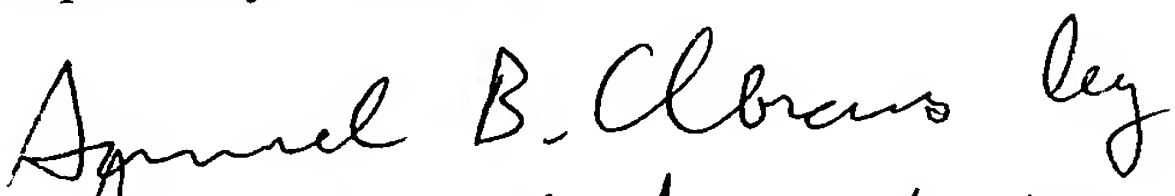
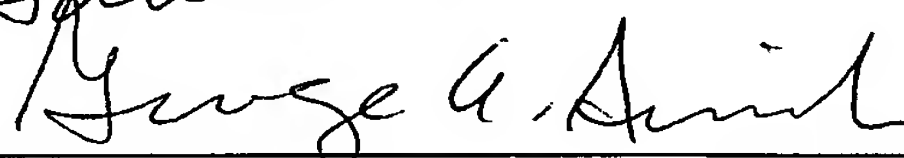
Attorneys for Applicants retain the right to petition from this Restriction Requirement under 37 C.F.R. § 1.144.

Applicants respectfully request that the present statement be entered and made of record in the above-identified patent application.

Other than the fee for the petition to extend time to respond to the Office communication, no fee is believed to be due for this response. Should any fee be required, please charge such fee to Jones Day Deposit Account No. 50-3013.

Respectfully submitted,

Date: March 22, 2006


 42,140

Samuel B. Abrams (Reg. No. 30,605)

JONES DAY
222 East 41st Street
New York, New York 10017
(212) 326-3939